



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,887	02/09/2001	George A. Pecoraro	1657A1	9023

24959 7590 02/11/2004  
PPG INDUSTRIES INC  
INTELLECTUAL PROPERTY DEPT  
ONE PPG PLACE  
PITTSBURGH, PA 15272

EXAMINER

BOLDEN, ELIZABETH A

ART UNIT	PAPER NUMBER
----------	--------------

1755

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

022

<b>Office Action Summary</b>	<b>Applicati n N .</b> 09/780,887	<b>Applicant(s)</b> PECORARO ET AL.	
	<b>Examin r</b> Elizabeth A. Bolden	<b>Art Unit</b> 1755	

-- The MAILING DATE f this c mmunication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14-16, 18, 19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-16, 19 and 26 is/are rejected.
- 7) ☒ Claim(s) 18, 21 and 23-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>16</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on 3 December 2003 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of any patent granted on Application Number 09/974,124 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Election/Restrictions***

Newly amended claim 22 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim 22 is directed towards a method of making a glass.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 22 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1755

Claims 19 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19 and 26 are rejected for reciting a range for the CaO/MgO content that fails outside of the possible ranges as defined by the individual ranges of the components and the combined range for the two components in the instant claims. For example it is unclear how the Applicants' can achieve a CaO/MgO ratio of 2 when the glass requires that the content of CaO is greater than 9 and the content of MgO is less than 4, while the range of CaO+MgO is from 12-13.4. Based on a CaO content of 9.1 and a MgO content of 3.9 the lowest possible ratio would be 2.33.

#### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-16 and 26 are rejected under 35 U.S.C. 102(e) as being Nakashima et al. by 6,313,052.

Nakashima et al. disclose a glass substrate having overlapping ranges of components with instant claims 14-16 and claim 26. See abstract of Nakashima et al. The compositional ranges disclosed by the reference are sufficiently specific to anticipate the compositional limitations in claims 14-16 and 26. See MPEP 2131.03. Nakashima et al. further disclose Example 20, which anticipates all the limitations of claims 14-16 and 26. See Table 3.

***Allowable Subject Matter***

Claims 18, 21, and 23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Independent claim 19 is rejected as indefinite, if the claim was amended such that the CaO/MgO range was proper the claim would be allowable over the prior art for the following reasons. The prior art fails to teach or suggest a glass composition having the composition and thermal properties as recited in the instant claims. Specifically, a glass composition having the recited relationships between CaO/MgO, CaO+MgO, and Na<sub>2</sub>O+K<sub>2</sub>O, which results in the recited properties.

***Response to Arguments***

Applicant's arguments see pages 5-7, filed 4 December 2003, with respect to the 35 U.S.C. 102(b) rejection over Morimoto et al. and Seto et al. have been fully considered and are persuasive. The rejection of claims 14-16, 18, 19, and 21-26 over Morimoto et al. and Seto et al. has been withdrawn. Morimoto et al. does not disclose an Al<sub>2</sub>O<sub>3</sub> range, which anticipates the instant claims and Seto et al., does not disclose an Fe<sub>2</sub>O<sub>3</sub> range, which anticipates the instant claims.

Applicant's arguments see pages 6-7, filed 4 December 2003, with respect to the 35 U.S.C. 102(b) rejection over Nakashima et al. have been fully considered and are persuasive with

Art Unit: 1755

respect to claims 18, 19, 21, 23-25. The rejection of claims 18,19, and 21-25 over Nakashima et al. has been withdrawn.

Applicant's arguments in view of Nakashima et al., filed 4 December 2003 have been fully considered but they are not persuasive. Applicants argue that the glass of Nakashima et al. do not disclose the required  $\text{Al}_2\text{O}_3$ , CaO/MgO and log 2 and log 4 viscosities as recited in the claims. This is not deemed persuasive since Nakashima et al. discloses Example 20, which meets all the limitations of claims 14-16 and 26. See above rejection and Table 3.

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., log 2 and log 4 viscosity) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 571-272-1363. The examiner can normally be reached on 9:30 am-7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1755

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EAB  
7 February 2004

  
**KARL GROUP**  
**PRIMARY EXAMINER**  
**GROUP 1755**